

APP 3626  
#34  
Ref  
Brief  
5/18  
10/2/02

TR (General - Patent Pending)	Docket No. P 97 194.024
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In Re Application of: Ronald L. Carr

Serial No. 08/952,001 ✓	Filing Date November 7, 1997	Examiner Alison Pickard	Group Art Unit 3626
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Title: JOINT ASSEMBLY EMPLOYING MULTI-RING GASKET

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

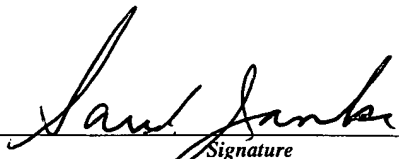
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Dated: March 31, 2003

Garth Janke, Reg. No. 40,662  
BIRDWELL, JANKE & DURANDO, PLC  
1100 SW Sixth Avenue, Suite 1100  
Portland, Oregon 97204  
Tel: 503-228-1841

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L.H. Rouske

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UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT EXAMINING OPERATIONS

Applicant: Ronald L. Carr

Group Art Unit: 3626

Serial No.: 08/952,001

Examiner: A. Pickard

Filed: November 7, 1997

Docket No.: P 97 194.024

Title: JOINT ASSEMBLY EMPLOYING MULTI-RING GASKET

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service addressed to: Commissioner for Patents, Washington, DC 20231 on this <sup>31</sup>st day of March, 2003.

*L.H. Rouske*  
L.H. Rouske

Birdwell, Janke & Durando, PLC  
1100 SW Sixth Avenue, Suite 1400  
Portland, OR 97204

March 31, 2003

REPLY

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Greetings:

This is a reply to the Examiner's Answer, originally mailed January 31, 2003 to an incorrect address. The Reply was remailed on March 21, 2003, and was not received in this Office until March 27, 2003. The examiner and the examiner's supervisor refused to reset the period for response, and a petition to the Commissioner to have the period for response reset is being filed today.

### Grouping of Claims

The Answer indicates that claims 55 and 85 are considered to stand and fall together. It is respectfully submitted that claims 55 and 85 cannot stand or fall together because these are both independent claims.

### Response to Arguments

#### Regarding Claim 55

##### Review of the Rejection

Figure 3 of Merwarth shows an inner ring A, an outer ring F, and a retaining ring B which includes eyes C that are connected to the outer ring F. The Office Action alleges that the inner ring A corresponds to the claimed first strip, the outer ring F corresponds to the claimed second strip, and the eyes C (and therefore the ring B of which the eyes C are an integral part) corresponds to the claimed "at least one spoke."

1) Page 5 (last line) - Page 6, line 1: The Examiner's Answer asserts that Appellant's arguments only apply only to the embodiment of Figure 1 and not to the embodiment of Figures 3 and 4.

In response, Appellant points out the following:

- (1) Merwarth states that "[l]etters of like name and kind refer to like parts in each of the figures" (Page 1, lines 42 - 43). Since the embodiment of

Figures 3 and 4 uses letters of like name and kind to those used in Figure 1, the parts A, B, and C are the same in both embodiments.

- (2) Merwarth also explains that the embodiment shown in Figures 3 and 4 is the same as the embodiment of Figure 1 except that it includes, in addition, “a second soft-metal packing ring F . . . .” See Page 2, lines 11 - 21.
- (3) The existence of the second packing ring F is not disclosed to have any consequence to the comparative qualities of the wire B (and C) and the wire A.

2) Page 6, lines 4 - 6: The Answer agrees that Merwarth does not disclose that the wire C and the wire A are the same material as claimed. Yet it is asserted that it is the same material because “there is no indication” that it is a different material. In response, Applicant points out the following:

- (1) According to MPEP 2144, obviousness requires an affirmative teaching or suggestion to reach the claimed invention, not merely a lack of any indication regarding the invention one way or the other.
- (2) More importantly, Appellant has shown<sup>1</sup> that the reference teaches against the invention, which is certainly “an indication” that the reference does not disclose what is claimed.

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<sup>1</sup> See pg. 16 of Applicant’s Appeal Brief.

3) Page 6, lines 8 - 10: The Answer states that Appellants argued that “the ring B (and therefore the spokes C) must be harder than ring A or the gasket will be destroyed because ring B will no longer serve as a “retaining ring.”

Please note that Appellant did not make such an argument. Appellant argued that the reference teaches making the ring B harder than the ring A so that it can serve as a retaining ring. In an obviousness rejection, what matters is what the reference teaches (See MPEP 2142), not what modifications may or may not be made as a result of hindsight of Applicant’s invention (See MPEP 2143.01).

4) Page 6, lines 12 - 14: The Answer states that “Even though ring B is disclosed as a harder metal for the embodiment of Figure 1, the spokes C (of Figure 3) are now disclosed as a soft metal because they serve a different function than in the other embodiment.”

As pointed out above, Merwarth instructs that “[l]etters of like name and kind refer to like parts in each of the figures.” The parts B and C are the same in Figures 1 - 4. Although the ring B in Figure 3 has the additional function of sealing, it cannot be assumed that the ring B no longer functions as a retaining ring.

Moreover, there is no issue about whether Merwarth discloses forming the different parts of its gasket with soft metals. The issue is whether Merwarth discloses forming all of the parts of the gasket of the same soft metal. This statement in the Answer does not address the issue.

5) Page 6, lines 19 - 21: The Answer states that “Merwarth discloses many embodiments, not all of which include a harder retaining ring.” As support for this assertion, the Answer refers to Figure 5 and page 2, lines 35 - 38 of the patent.

The embodiment of Figure 5 uses different reference designators than the embodiment of Figures 1 - 4, and therefore differs therefrom according to Merwarth’s instruction noted above in (4). This embodiment differs radically from the claimed invention, and does not have two strips with at least one spoke extending between the two strips. Merwarth describes the ring G in Figure 5 as being “a single soft metal ring.” Page 2, lines 36 - 37. It is of no disclosed or apparent consequence that the single soft metal ring is formed “of two such rings placed one inside the other,” as the result is simply to provide a single soft metal ring as stated. A series of eyes G’ are soldered to the ring which engage the bolts of the pipe flange. The eyes G’ are formed of “sheet metal” that is “thin enough to permit the packing-ring to be properly compressed.” Page 2, lines 43 - 45. Accordingly, the embodiment of Figure 5 provides only a single soft metal ring for sealing and sheet metal eyes that perform no sealing function at all, so this embodiment teaches further away from the gasket of claim 55 than does the embodiment of Figures 1 - 4.

6) Page 6, line 20 - Page 7, line 1: It is asserted that the objective of Merwarth is to provide a gasket that is effectively centered on and seals the joint for containing or conveying fluids or liquids “whether under pressure or not” (citing page 1, lines 45 - 54) (emphasis added). Therefore, it is asserted that making the retaining ring B out of a harder metal is not critical in Merwarth.

Appellant points out that a gasket adapted for use “whether under pressure or not” logically must be adapted for use under pressure, because if the gasket were not adapted for use under pressure, it would not work “whether under pressure or not.” Therefore, contrary to the assertion in the Answer, it is absolutely critical to adapt the gasket in Merwarth for use under pressure to successfully create a gasket that can function “whether under pressure or not” as stated.

7) Page 7, lines 2 - 3: The examiner submits that the ring B would still function as a retaining ring when made out of the same material as A (or F). Depending on what is meant by the word “function,” this may be a correct statement. However, as explained in Appellant’s Appeal Brief “”if the rings A and B were formed of wire having both the same size and the same softness as proposed in the Office Action, the ring B would no longer be any stronger than ring A, so that the essence of providing a relatively strong retaining material around the ring A would be lost.” Therefore, even though the ring B may still function if it were formed of the same material as the ring A, it would not function as well to achieve the purpose taught, so it cannot be said that the reference teaches or suggests forming the rings A and B of the same material.

8) Page 7, line 8: The argument that forming the gasket of Merwarth as claimed is merely a design choice is maintained. This argument has two fundamental flaws:

a) This argument does not consider that Merwarth teaches to the contrary, as argued by Appellant in his Appeal Brief.<sup>2</sup> A reference may not be modified contrary to its disclosed principle of operation (See MPEP 2145(X)(D)).

b) This argument also does not consider that there is no ground in the MPEP for rejecting a claim based on a mere assertion of design choice. Appellant requested that the examiner identify the authority for the rejection in the MPEP or in the case law, but not such authority has yet been mentioned.

9) Page 7, lines 16 - 18: The Answer states: "Nowhere has it been proposed that using the same material provides ease in manufacturing considerations because the gasket parts can be made integrally. Even though it could be, the examiner is not implying that it has to be."

To clarify the point made in the Appeal Brief, the "ease of manufacturing" assertion was raised by the examiner as a rationale (under MPEP 2144) for modifying the prior art in the absence of any reference teaching the modification. Appellant merely pointed out that, unless the gasket were formed integrally, there would not be any clear manufacturing advantage. Therefore, the rationale proposed by the examiner presupposes an integral configuration which is not claimed. Appellant was not arguing that the gasket has to be formed integrally--indeed it is not formed integrally in Merwarth.

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<sup>2</sup> It should also be noted that the Answer provides no rebuttal to Applicant's arguments in this regard.



In any event, even if there were a manufacturing advantage, it would not matter, because the reference may not be modified contrary to its disclosed principle of operation (See MPEP 2145(X)(D)).

10) Page 7 (last line) - Page 8, line 3: The Answer poses the following questions:

“[W]hy, when Merwarth clearly discloses that ‘soft metal’ is used for the express purpose of sealing, would one of ordinary skill in the art not use the same soft metal at each location (first strip, second strip, and spokes) to create the seal? Why would one choose three separate soft metals to do the job?”

Appellant has already answered these questions. It has already been explained that Merwarth teaches providing a retaining ring that supports the soft inner ring. Though this can be formed of a “soft” metal, it is readily apparent that it will do a better job of retaining if it is stronger (and therefore harder) than the inner ring. It is readily apparent that the outer ring can still be soft enough to provide some sealing function yet be harder than the inner ring, and a good reason for this is that sealing on the outer periphery of the flange is not as critical as sealing close to where the fluids are flowing (in the interior of the pipe). Therefore, the inner ring should be better at sealing (and therefore softer) and the outer ring should be better at retaining (and therefore harder), even though both provide sealing. In posing these questions, it is apparent that the Examiner’s Answer has not addressed Appellant’s arguments in this regard.

Regarding Claim 85

11) Page 8, lines 4 - 8: The Answer cites *In re Dailey*, 357 F.2d 669, 149 U.S.P.Q. 47 (CCPA 1966) for the proposition that “changes in shape are considered obvious design choices absent persuasive evidence.” A copy of *In re Dailey* is enclosed for reference. In regard to the patentability of claims involving a change in shape, *In re Dailey* held precisely as follows:

Appellants have presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container of Matzen.”

Accordingly, *In re Dailey* merely states that a configuration that is not significant or is not anything more than numerous configurations already known in the art is obvious. Neither of these conditions is met here: (A) Appellant has already pointed out how the square shape is significant, and (B), there is no reason for the examiner to presume that square gaskets are merely one of numerous configurations known in the art; not a single reference of record discloses a gasket having a square shaped outer periphery. All of the gaskets shown in the references of record are either round or, if they have some other configuration, the configuration matches the configuration of the part being sealed.

12) Page 8, lines 11 - 16: The Answer points to Appellant's argument that the square corners are available to protrude from a round pipe flange, and states that Appellant is arguing about limitations that are not in the claims.

Appellant is not arguing about limitations at all, and the limitations are not at issue. Applicant claims a gasket having a square outer periphery. Appellant is merely pointing out that the gasket inherently provides a feature that has an identifiable mechanical function, e.g., it can be used to advantage in a round pipe flange. The existence of any sort of mechanical function is all that is required to defeat the examiner's allegation that the shape limitation can be ignored in assessing the patentability of the claim. See MPEP 2144.01(I) and discussion at (16) below. It is not necessary that the shape provide an advantage over the prior art, though it certainly does in certain circumstances as the examiner recognizes (see quotation at (16) below). It should also be understood that there is no requirement that the claimed gasket ever be used in a round pipe flange, or that it ever be used at all.

14) Page 8, lines 17 - 21: The Answer states that "there is no criticality supported in the specification as to shape" and "no mention of the purpose of the square shape, or any problems solved with the square shape."

The issue is whether the claimed shape has some functional significance or whether it is just arbitrary and merely one design choice among numerous others. Whether the shape does in fact have a functional significance does not depend, either logically or legally, on what is stated in the specification. This is made clear in MPEP 716.02(f), which states (citing *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995):

Although the purported advantage . . . was not disclosed in the specification, evidence and arguments rebutting the conclusion . . . [of the claimed feature being] merely a 'design choice' should have been considered as part of the totality of the record. "We have found no cases supporting the position that a patent application's evidence or arguments . . . must be contained in the specification." (emphasis added).

Please note in addition that the court in *In re Dailey* (cited in the Examiner's Answer) did not find the claimed shape obvious because its function was not explained in the specification--it found the shape obvious because:

"Appellants have presented *no argument* which convinces us that the particular configuration of their container is significant" (emphasis added).

Here, Appellant has provided an argument that the configuration is significant, and the technical correctness of the argument remains undisputed.

15) Page 8, line 21: The Answer asserts that "[t]o allow the argued features would be new matter." This allegation has never before been made, and should therefore be disregarded immediately as raising new issues.

In addition, Appellants point out that all of the features claimed in claim 85 are shown in Figures 14 and 15 as originally filed, and that these features were also present in the claims as originally filed. Therefore, nothing in claim 85 can be considered new matter.

16) Page 9: The examiner maintains the assertion that the “circular shape in Mastin would work equally well” as the claimed shape, stating:

“For as many environments that Appellant can argue the square shape would be better than the circular shape . . . the examiner can argue as many where the circular shape is just as good . . . .”

The examiner apparently concedes that there are at least some circumstances in which the claimed shape provides an advantage over the prior art. Moreover, since pipe joints are almost invariably round, it would seem that such circumstances are by far the more commonplace.

Regardless, the issue according to MPEP 2144.04(I) is whether the square shape has “no mechanical function” and relates to “ornamentation only” as is being alleged. Therefore, the issue is not whether there are some conceivable environments in which the invention could be placed in which its inherent mechanical function would be of no avail, or would fail to provide an advantage over the prior art (as characterized above). Since it is admitted and agreed that the square outer periphery has a mechanical function, whatever may be the its benefits relative to the prior art and whatever may be the circumstances under which it is achieved, no issue remains and maintaining the rejection on the given grounds is improper.

Again, claim 85 is drawn to a gasket that is (a) novel, and (b) not taught or suggested by the prior art. The fact that it is possible to use the invention in circumstances under which it does not work very well, or does not work as well it could work, is not a legally permissible reason to consider the invention unpatentable.

For all of the above reasons as well as the reasons presented in the Appeal Brief, it is submitted that the rejections should be over-ruled and the case passed to issue.

Respectfully, submitted

A handwritten signature in black ink, appearing to read 'Garth Janke', written in a cursive style.

Garth Janke  
Reg. No. 40,662  
(503) 228-1841

writ of habeas corpus, appellant as grounds for relief several acts in a state court conviction, conviction led to the revocation of his parole from federal custody. He asserts that the District Court is granting him a hearing on

appellant's contentions are with- Since petitioner was at the filing of his petition and is in federal custody as a result of the revocation of his parole from a federal court, he has no grounds for review of his state conviction, whether properly obtained or not." *Wright v. Hagan*, 3rd Cir., 1960, 287 F.2d 101, cert. denied, 1961, 366 U.S. 934, 6 L.Ed.2d 1259.

Thus there was no need to say anything in this case. Even if we view the petition as attacking the denial of appellant's parole, we are not at the Parole Board had been sufficient evidence to justify revocation. *Wright v. Settle*, 61, 293 F.2d 317, 319, the question whether a parole violation is subject to being raised in a habeas corpus "only on the narrow ground that what was before the Board was a conclusion as a matter of fact that there had been no violation of the conditions of release or parole, and the Board therefore acted without making the revocation."

53 CCPA

Application of Donald E. DAILEY and Anton F. Ellers.

Patent Appeal No. 7491.

United States Court of Customs and Patent Appeals.

March 24, 1966.

Appeal from Patent Office Board of Appeals affirmance of examiner's rejection of claims 25 through 28 of application Serial No. 814,110. The Court of Customs and Patent Appeals, Worley, Chief Judge, held that claims 25 through 28 of application for patent, relating to disposable nursing container for infants, were unpatentable for obviousness.

Affirmed.

Smith, J., dissented.

#### Patents ¶18

Claims 25 through 28 of application for patent relating to disposable nursing container for infants were unpatentable for obviousness.

John Rex Allen, Chicago, Ill. (Richard S. Phillips, Chicago, Ill., of counsel), for appellants.

Clarence W. Moore, Washington, D. C. (J. F. Nakamura, Washington, D. C., of

counsel), for the Commissioner of Patents.

Before WORLEY, Chief Judge, and RICH, MARTIN, SMITH and ALMOND, Judges.

WORLEY, Chief Judge.

This appeal is from the decision of the Board of Appeals which affirmed the examiner's rejection of claims 25-28 in appellants' application<sup>1</sup> for "Nursing Container."

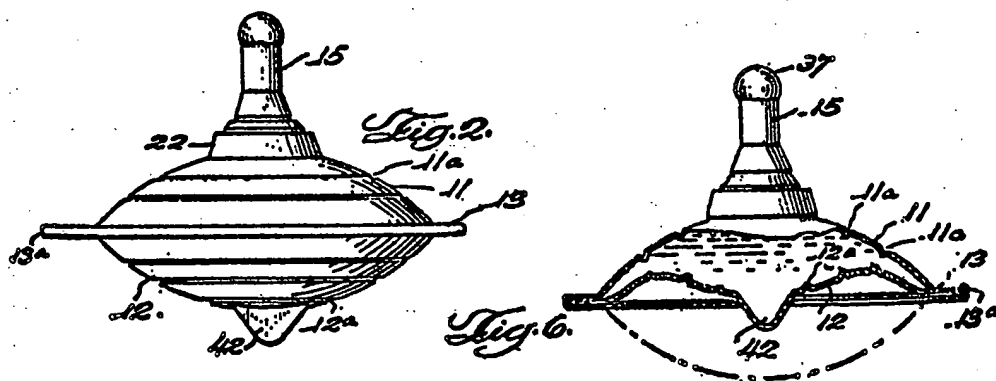
The invention relates to a disposable nursing container for infants. Appellants state:

The nursing container with which the invention is concerned is collapsible so that air is not admitted as the contents are drained. Accordingly the likelihood of the infant swallowing air during feeding, believed to be a major cause of colic, is reduced.

\* \* \* \* \*

A further feature is that the top section of the container has the nipple receiving opening therein and the bottom section is collapsible into the top section. The bottom section is more flexible than the top section to facilitate the collapse thereof.

The particular construction which appellants disclose to achieve those results is illustrated in the following drawings:



1. Serial No. 814,110, filed May 18, 1959.

Appellants describe that construction and its use in their specification as follows:

Top and bottom sections 11 and 12 of container 10 are preferably of a thin formed plastic sheet material or the like. By "plastic" any suitable flexible material is intended, including rubber, synthetic plastics and the like. \* \* \* Both sections have a generally spherical configuration and are somewhat less than hemispherical in extent. In the specific container illustrated in the drawings, the two sections are defined by a central angle of the order of 80°. This relationship provides a finished container which has a rounded configuration and is convenient to hold. \* \* \*

At the time of feeding, \* \* \* pressure [is applied] to the wall of the container forcing the nipple out. At the same time, any air left in the container during filling is expelled through the nipple so that the infant swallows no air from the container. \* \* \*

\* \* \* \* \*  
If the infant requires stimulation to cause it to nurse properly, a slight pressure applied to the bottom of the container by the palm of the hand forces some of the formula out through the nipple into the infant's mouth. As the formula is withdrawn from the container the bottom section 12 collapses within the upper section 11 as indicated in Figure 6 forcing formula into the nipple keeping it filled. This collapse starts at the juncture line 13 between the container sections and progresses inwardly therefrom so that formula is not trapped between collapsed portions of the bottom section wall and the wall of the top section. *It is not necessary for air to enter the container as the formula is withdrawn and the cross cut nipple acts as a check valve allowing only the outward flow of formula and restricting inward flow of air.* Thus the likelihood of the infant swallowing substantial quantities

of air during nursing is reduced. As the container and nipple are free of air at all times during feeding, it is not necessary that the container be elevated above the infant, but it may be in any position above or below. \* \* \* [Emphasis supplied.]

Claim 25 is illustrative:

25. A disposable, plastic infant nursing container of the character described, comprising: a top section of self-sustaining formed material having a nipple opening therein; a bottom section of self-sustaining, formed flexible plastic material sealed to the first section and collapsible thereinto, said bottom section being more flexible than the top section and having a shape such that in the collapsed condition is closely mated with the interior of the top section, said bottom section retaining a position in which it is placed, whereby the bottom section readily collapses upon the withdrawal of the container contents, without retarding or aiding the flow of the contents therefrom; and a nipple mounted on said top section and communicating with the opening therein, said nipple having a slit therein defining a valved nursing opening, whereby the interior of the container is sealed and during nursing the container contents are withdrawn without admission of air to the container, causing collapse of the bottom container section.

Claim 26 defines the valved nursing opening as a cross-cut valve. Claim 27, while defining no particular nipple opening structure, recites the configuration of the top and bottom sections of the container as that of "a portion of a sphere less than a hemisphere." In claim 28, the central angle of those spherical portions is about 80°.

The references are:

Matzen	554,071	February 4, 1896.
Bardin	2,433,806	December 30, 1947.
Allen	2,446,451	August 3, 1948.
Blanchett	2,989,961	June 27, 1961.

Matzen's nursing bottle following drawing:



Matzen's object is:

\* \* \* to provide a bottle in which air is admitted and in which the milk is formed as the milk is drawn into the baby, and \* \* \* a bottle from which the milk is drawn continuously and evenly, the size of the opening in the nipple being adjustable. The patentee describes his invention as consisting of a nursing-bottle of two parts, one of which is rigid, and in which the other part operates to prevent the bottle as the milk is drawn into the child and promotes even flow, \* \* \*.

\* \* \* \* \*  
\* \* \* Fig. 2 is a view of the bottle when the two parts are collapsed. When the bottle has been emptied, the flexible part is drawn into the rigid part. While part A is made of a rigid material, part B consists of a flexible material.



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er and nipple are free of  
times during feeding, it is  
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position above or below.  
Emphasis supplied.]

s illustrative:

disposable, plastic infant  
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mprising: a top section of  
ing formed material have  
e opening therein; a bottom  
elf-sustaining, formed flexi-  
material sealed to the first  
l collapsible thereinto, said  
ction being more flexible  
top section and having a  
that in the collapsed con-  
closely mated with the in-  
he top section, said bottom  
aining a position in which  
d, whereby the bottom sec-  
ly collapses upon the with-  
the container contents, with-  
ing or aiding the flow of the  
therefrom; and a nipple  
n said top section and com-  
g with the opening therein,  
e having a slit therein de-  
valved nursing opening,  
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tents are withdrawn with-  
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s-cut valve. Claim 27, while  
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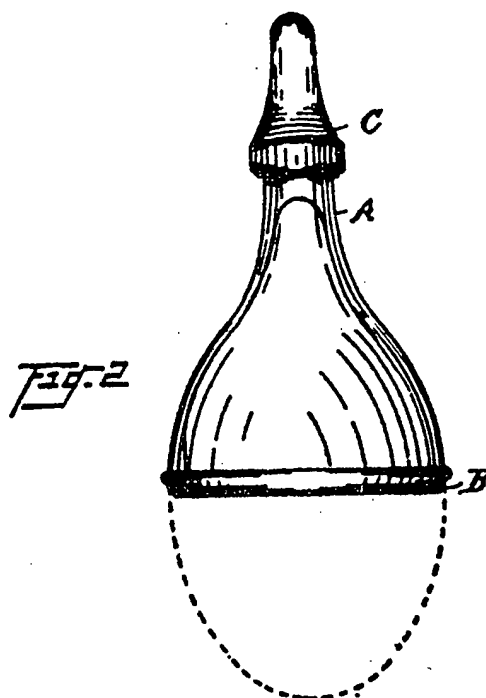
554,071 February 4, 1896.  
433,806 December 30, 1947.  
446,451 August 3, 1948.  
989,961 June 27, 1961.

## APPLICATION OF DAILEY

Cite as 357 F.2d 669 (1966)

671

Matzen's nursing bottle is shown in the  
following drawing:



Matzen's object is:

\* \* \* to provide a bottle in which no  
air is admitted and in which no vacuum  
is formed as the milk is withdrawn by  
the baby, and \* \* \* to provide a  
bottle from which the milk will flow  
continuously and evenly, whatever the  
size of the opening in the nipple.

The patentee describes his construction  
as consisting

\* \* \* of a nursing-bottle made of  
two parts, one of which is flexible, the  
other rigid, and in which the flexible  
part operates to prevent a vacuum in  
the bottle as the milk is drawn out by  
the child and promotes evenness in the  
flow, \* \* \*.

\* \* \* \* \*  
\* \* \* Fig. 2 is a view of said bottle  
when the two parts are connected and  
the bottle has been substantially  
emptied, the flexible part in this case  
being drawn into the rigid part.

While part A is made of a rigid material,  
part B consists of

\* \* \* flexible material so thin and  
light that it will readily respond to the  
suction of the infant through the nip-  
ple and surrender itself to such suction  
with practically no resistance whatever  
of its own, thus following the with-  
drawal of the milk and at last losing  
itself bodily in the upper half, A, and  
filling the space thereof, as seen in  
Fig. 2. I believe that a good quality of  
elastic rubber is the best material from  
which to make the part B, and now use  
very thin vulcanized rubber for this  
purpose. \* \* \*

Matzen describes the use of his container  
thus:

\* \* \* The nipple is put on and then  
the collapsible part B is compressed  
until all of the air is forced out through  
the hole in the nipple, whereupon the  
bottle is ready to give to the child. As  
the baby sucks the milk from the bottle,  
the collapsible part B is gradually  
drawn into the part A, thus reducing  
the capacity of the bottle, and this goes  
on until the milk is withdrawn and  
said part B substantially fills the part  
A, \* \* \*.

Matzen noted several problems with  
respect to "ordinary" nursing bottles. In  
the use of the ordinary rigid glass bottle,  
the nipple construction necessarily must  
allow air to be admitted into the bottle, or  
the flow of milk will cease. Thus the in-  
fant had to stop sucking frequently in  
order that air may be admitted. The  
presence of air in the bottle results in the  
baby sucking in air with the milk, with  
colic as a consequence. The nipple open-  
ing in the ordinary bottle had to be rela-  
tively large; if small, on the order of a  
pinhole, the rubber surrounding the hole  
effectively sealed the nipple opening to  
entry of air and prevented further with-  
drawal of milk as well. On the other hand  
Matzen stated:

\* \* \* if the hole in the nipple is so  
large that it will not close up and ex-  
clude the air, it is at the same time so  
large that the baby gets the milk too  
fast.

With my bottle the finest pin-hole  
may be formed in the nipple, and a

small but regular and uninterrupted stream will flow through it.

Matzen also noted his bottle

\* \* \* has the exceptional and distinguishing advantage of being ready to yield its contents to the child whatever the position of the bottle may be. Indeed, one position is practically as good as another and the milk comes freely in all positions. \* \* \*

A detailed discussion of Allen appears unnecessary, beyond noting he discloses a similar nursing container having a bottom portion which

\* \* \* automatically collapses and retracts into the rigid neck as the last of the liquid is sucked from the container by an infant using the nursing unit, in this way providing a non-colic nursing unit in view of the fact that no accumulation of air is permitted within the container.

Blanchett discloses a nipple construction for use with ordinary rigid nursing bottles in which the nipple opening may consist of a cross cut, an I cut, a Y cut, a single hole, or multiple holes. Blanchett states:

\* \* \* The various "cuts" are preferable to the holes because they do not leak when the nursing unit is turned upside down. Neither do they become plugged.

The board did not find it necessary to discuss Bardin, nor do we.

The board agreed with the examiner that claims 25-28 were unpatentable over Matzen or Allen in view of Blanchett. It found claims 25 and 26 to distinguish over Matzen only in terms of the type of nipple opening employed, and claims 27 and 28 to distinguish only in reciting a "less than a hemisphere" configuration. In answer to appellants' argument that their particular slit nipple opening provides a self-sealing action to prevent continuous

flow and loss of formula from the nurser, the board noted that Blanchett fully appreciated the ability of such an opening to prevent leaks. With respect to claims 27 and 28, it further agreed that the configuration of the container is a "mere matter of choice" not significantly novel over Matzen.

Appellants urge that Matzen is devoid of any suggestion of the desirability of combining a collapsible container with a valved nipple which is responsive only to the sucking of the infant, thereby providing intermittent milk flow. Indeed, appellants state that Matzen promotes the idea of a nipple with a pinhole in it as desirable in order to obtain regular and uninterrupted flow of milk from the container.<sup>2</sup> It is appellants' position that the prior art recognizes neither the problem nor result desired and cannot be said to suggest a solution to the problem.

Taking appellants' argument at face value, we think one skilled in the art could hardly be unaware, after reading Matzen, that continuous flow or leakage might be an undesirable feature of the Matzen nursing container construction. Blanchett also recognizes the problem of fluid leakage from a hole opening in a nipple when the container is held upside down and, in a matter-of-fact manner, discloses the solution to that problem—the use of a "slit" nipple opening. We think one of ordinary skill in the art would find it obvious to use the slit nipple of Blanchett in the collapsible container of Matzen in order to achieve intermittent flow responsive to sucking.

As noted above, Matzen discloses that the flexible portion of his container is drawn into the rigid top portion, filling the space thereof. Appellants have presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configura-

ly likely that Matzen's container, having a nipple with a pinhole, provides a continuous flow only so long as the infant is sucking, which the infant may do without necessity of stopping to allow air into the container.

tions a person of ordinary skill would find obvious for the providing mating surfaces of a collapsed container of Matzen. *v. John Deere Co. of Kan.* S.Ct. 684.

The decision of the board is Affirmed.

SMITH, Judge, dissenting.

The majority opinion states support as to either the facts it predicates the opinion or that it applies thereto. Its logic is obvious logic which leads to the conclusion that since each of the words "Gettysburg Address" were old and well known at the time, it would have been obvious to one of ordinary skill with a degree of logic which supports the conclusion of the majority here from which we see that today with "The Gettysburg Address" before him, it would be as easy for any school boy to select the words and place them in the same order.

The fallacy I find in the majority opinion has its genesis in its selection of those facts of record which disprove its conclusion. Ignoring the obvious, it requires the majority to ignore the precise wording of the claim and the facts thereto. This is understandable only if the majority opinion is correct, there is no support for its reasoning.

As a preliminary observation, I noted that all the appellants' arguments are drawn to a combination of elements which separately may be old, but which, taken together, does not warrant the treating of the claims as claiming a new combination of individually old elements. I find no combination of these elements claimed.

It seems necessary from time to time to comment on the human tendency to do what was in the light of the accomplishment of the invention. This is so old that a repetition of the same comments of some 300 years ago in "Paradise Lost" seems both appropriate and timely here.

loss of formula from the nurser, noted that Blanchett fully appreciated the ability of such an opening to saks. With respect to claims 27 further agreed that the configuration of the container is a "mere matter" not significantly novel over

its urge that Matzen is devoid of suggestion of the desirability of a collapsible container with a nipple which is responsive only to the sucking of the infant, thereby permitting milk flow. Indeed, Matzen states that Matzen promotes the nipple with a pinhole in it as a means to obtain regular and continuous flow of milk from the container. It is appellants' position that Matzen recognizes neither the problem nor the desired and cannot be said to have a solution to the problem.

Appellants' argument at face value is that one skilled in the art could have known, after reading Matzen's disclosure, that a continuous flow or leakage through a nipple is an undesirable feature of the container construction. Matzen does not recognize the problem of leakage from a hole opening in a container which is held upside down in a matter-of-fact manner. It is a solution to that problem—a "slit" nipple opening. We do not find ordinary skill in the art to be obvious to use the slit in Matzen's container in order to achieve a container responsive to sucking.

Above, Matzen discloses that a portion of his container is a rigid top portion, filling the container. Appellants have presented argument which convinces us that the configuration of their container is significant or is anything other than a mere configuration of numerous configura-

Matzen's container, having a pinhole, provides a container only so long as the infant does not stop sucking. The high the infant may do without stopping to allow air into

tions a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container of Matzen. See *Graham v. John Deere Co.* of Kansas City, 86 S.Ct. 684.

The decision of the board is affirmed. Affirmed.

SMITH, Judge, dissenting.

The majority opinion stands without support as to either the facts upon which it predicates the opinion or the law which it applies thereto. Its logic is the fallacious logic which leads to the conclusion that since each of the words in Lincoln's "Gettysburg Address" were individually old and well known at the time he used them, it would have been obvious for anyone of ordinary skill with a dictionary before him, to have written it. It is this logic which supports the conclusion of the majority here from which we may assume that today with "The Gettysburg Address" before him, it would be obvious for any school boy to select the same words and place them in the same order.

The fallacy I find in the majority opinion has its genesis in its simply ignoring those facts of record which do not support its conclusion. Ignoring these facts also requires the majority to ignore the precise wording of the claims directed thereto. This is understandable for unless the majority opinion is so construed, there is no support for its result.

As a preliminary observation it is to be noted that all the appealed claims are drawn to a *combination* of elements which separately may be old. This, however, does not warrant the majority in treating the claims as claims to the *individually old elements*. It is the new *combination* of these elements which is claimed.

1. It seems necessary from time to time to comment on the human frailty in judging what *was* in the light of the *fait accompli* of the invention. This frailty is so old that a repetition of Milton's comments of some 300 years ago in "Paradise Lost" seems both appropriate and timely here.

It is this *combination* which must be found to be obvious under the conditions of 35 U.S.C. § 103 before the majority opinion can be justified.

The initial fallacy requires the majority to ignore the express limitations contained in 35 U.S.C. § 103 and to ignore the legislative intent which seems to have been clearly expressed thereby. The section explicitly provides that the determination of obviousness must be made on the basis of (1) considering "the invention as a whole" and (2) determining the issue of obviousness "as of the time the invention was made." The failure of the majority to here apply these portions of section 103 constitutes what I deem to be a grave error of law therein.

A proper reading of the statute shows the care with which section 103 was drawn to provide safeguards against the use of hindsight reconstruction of the art as has happened in this case. A proper respect for these safeguards would have avoided the fallacies which underlie the majority opinion.<sup>1</sup>

Turning to the appealed claims let us see what, in fact, they embrace. As will be shown, the appealed claims embrace significant features other than the collapsible wall of the container and the valved uni-directional flow nipple. Yet the majority rests its opinion on these features. No useful purpose will be served in repeating the features of the claims recited in the majority opinion. I fail, however, to find in the majority opinion any comment on the following features specifically set forth in appealed claim 25:

(1) a "disposable, plastic infant nursing container," in which

(2) the flexible bottom portion is "sealed to the first section" and

"The invention all admired, and each how he To be the inventor missed; so easy it seemed, Once found, which yet unfound, most would have thought Impossible!" (Part VI, L. 478-501)

(3) the shape of the flexible bottom section is "such that in the collapsed condition it closely mates with the interior of the top section" and

(4) the nipple has "a slit therein defining a valved nursing opening, whereby the interior of the container is sealed and during nursing the container contents are withdrawn without admission of air to the container, causing collapse of the bottom container section."

The fact is that the art relied upon by the majority is not concerned with providing a *disposable* container of the type here under consideration and having the claimed features specified in claim 25. While Allen shows a retractable disposable container, its use requires a rigid neck unit which obviously is not intended to be disposed of when the container is thrown away. The Matzen construction clearly is not of the disposable container type. Instead, the construction is such as Matzen states that:

\* \* \* The bead or rib *b* engages in groove *a'* and helps to make the engagement effective, and yet leave the parts free for the nurse to detach and wash and cleanse as they require.

Neither Allen or Matzen "seal" the flexible bottom section to the top section as disclosed by appellants and as claimed in claim 25.

Claim 25 also calls for the collapsed bottom section to be closely mated with the interior of the top section. Allen clearly shows no such concept. In Matzen the flexible bottom portion formed of flexible rubber may be drawn into the rigid top portion as the bottle is emptied, but is it closely mated as required in claim 25? I think not, as the view of Fig. 1 of Matzen clearly shows.

Neither Allen or Matzen shows a nipple of the type required to meet the language of the claim. Appellants explain that the nipple as shown and claimed will

provide an intermittent valved flow.<sup>2</sup> They state in their specification:

\* \* \*. It is not necessary for air to enter the container as the formula is withdrawn and the cross cut nipple acts as a check valve allowing only the outward flow of formula and restricting inward flow of air. Thus the likelihood of the infant swallowing substantial quantities of air during nursing is reduced. \* \* \*

Thus, it is the outer extremity of appellants' nipple which contains a slit which is normally closed. This slit opens in response to an infant's nursing. Absent a sucking action by the infant the slit remains closed. The decrease in pressure generated by such sucking opens the slit and causes nutrient to flow from the container. During outward flow of the nutrient, the top portion of the container remains rigid. However the bottom portion, being of flexible self-sustaining material, collapses into the top portion as the nutrient flows outward. When the flow stops, the bottom portion sustains its position. With this construction there is no entrapment of air or fluid within the folds of the collapsible container and the flow of nutrient stops when the infant stops sucking on the nipple.

This, however, does not preclude the majority from finding it obvious to use such a nipple. It finds the cross slitted nipple shown in one view of the nipple disclosed in the Blanchett reference. The majority opinion is silent as to how the Blanchett nipple *as disclosed*, when placed on the Allen or Matzen bottles, would let fluid out *without* letting air in. Unless this can be done, the purpose of Allen and Matzen is defeated, for if air enters as the fluid is drawn out, the flexible portions simply cannot be drawn into the rigid top portions as the majority finds Allen and Matzen intended.

If any one portion of the majority opinion can be said to be more unfair to appellants than another, it is the portion dealing with the Blanchett reference. Af-

ter ignoring Blanchett's entire construction selects from the construction the following:

Blanchett discloses a nipple for use with ordinary bottles in which the nipple may consist of a cross cut Y cut, a single hole, or more. Blanchett states:

\* \* \* The various [constructions] are preferable to the holes [disclosed] do not leak when the nipple is turned upside down. Nipples do not become plugged.

The use of the cross cut nipple as an air vent is first disclosed in the majority opinion by appellants. It is not disclosed in the Blanchett reference. Instead, for keeping air out of the container, Blanchett proposes is

\* \* \* an improved nipple consisting of having a new large valve which opens when suction is applied to the nipple, permitting amounts of air to enter the bottle, and which closes when suction is released, the contents of the bottle flow out. [Emphasis added.]

Blanchett describes the valve as follows:

The principle of operation of the valve is as follows: When the infant sucks through the sucking nipple, the pressure within the bottle is increased relative to atmospheric pressure. When the pressure differential is great enough to overcome the resiliency of the valve, the valve opens as shown in FIGURE 1, allowing external air to rush into the ends of the tube and through the aperture into the bottle, as indicated by the arrows in FIGURES 2 and 3. When the infant stops sucking, the pressure differential lessens, the natural resiliency of the tube valve aperture shut prevents further airage. The valve in the closed position is illustrated in FIGURE 4. [Emphasis added.]

2. In Matzen, the nipple opening is open at all times. No intermittent flow concept is suggested.

intermittent valved flow.<sup>2</sup>  
their specification:

It is not necessary for air to  
container as the formula is  
and the cross cut nipple acts  
valve allowing only the out-  
of formula and restricting  
ow of air. Thus the likeli-  
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ter ignoring Blanchett's entire invention,  
the majority after viewing appellants'  
construction selects from the Blanchett  
construction the following:

Blanchett discloses a nipple construc-  
tion for use with ordinary rigid nurs-  
ing bottles in which the nipple opening  
may consist of a cross cut, an I cut, a  
Y cut, a single hole, or multiple holes.  
Blanchett states:

\* \* \* The various "cuts" are  
preferable to the holes because they  
do not leak when the nursing unit is  
turned upside down. Neither do they  
become plugged.

The use of the cross cut nipple *without*  
an air vent is first disclosed in this record  
by appellants. *It is not disclosed in the*  
*Blanchett reference.* Instead of a nipple  
for keeping air out of the bottle, what  
Blanchett proposes is

\* \* \* an improved nipple as a re-  
sult of having a *new large capacity air*  
*valve which opens when suction is ap-*  
*plied to the nipple*, permitting adequate  
amounts of air to enter the nursing  
bottle, and which closes effectively  
when suction is released, preventing  
the contents of the bottle from leaking  
out. [Emphasis added.]

Blanchett describes the valve operation  
as follows:

The principle of operation of this  
valve is as follows: When the infant  
sucks through the sucking opening 9  
the pressure within the bottle is de-  
creased relative to atmospheric pres-  
sure. When the pressure difference is  
great enough to overcome the natural  
resiliency of the valve, the *aperture 2*  
*opens* as shown in FIGURE 2, *permit-*  
*ting external air to rush through the*  
*ends of the tube and through the valve*  
*aperture into the bottle*, as shown by  
the arrows in FIGURES 2 and 7. When  
the infant stops sucking and the  
pressure differential lessens, the  
natural resiliency of the tube snaps the  
valve aperture shut preventing leak-  
age. The valve in the closed position is  
illustrated in FIGURES 1 and 6.  
[Emphasis added.]

Should any question remain as to what  
the Blanchett air-valve nipple will do, it  
is answered by Blanchett as follows:

Thus, it will be seen that a more ef-  
ficient nipple has been provided which  
contains a new effective air valve. In  
particular, the advantages and con-  
veniences of this air valve in a baby  
nipple are mainly:

(1) The size of the valve aperture  
allows a larger volume of air to flow  
into the bottle in proportion to the in-  
fant's sucking effort than the old pin  
holes, vents, ridges and grooves.

(2) The valve has a more positive  
and effective closing action which pre-  
vents leakage.

(3) The valve does not become plug-  
ged even by the coarsest formula.

(4) No loosening or adjusting of the  
retaining screw cap which formerly  
caused leakage, is necessary.

(5) The valve is easily cleaned with  
soap and water. A pipe cleaner or  
small brush may be run through it to  
satisfy the most meticulous.

(6) The valve does not in any way  
interfere with sterilization or with  
transportation of the nursing unit  
when using the sealing disc.

The fallacy in the majority opinion, as  
it was in the opinion of the board, lies in  
ignoring the specific teachings of Blan-  
chett *which require that air be admitted*  
*to the container through his special large*  
*capacity air valve nipple.* To adapt the  
Blanchett nipple, *without the changes*  
*first suggested by appellants*, to the Mat-  
zen or Allen constructions would defeat  
the entire purpose of the collapsible por-  
tion of the Matzen or Allen constructions.

On the present record the first sug-  
gestion of the *combination* of the flexible  
wall construction and the one way nipple  
was made by appellants.

The majority opinion states:

\* \* \* We think one of ordinary skill  
in the art would find it obvious to  
use the slit nipple of Blanchett in the



collapsible container of Matzen in order to achieve intermittent flow responsive to sucking.

As above pointed out, "the slit nipple of Blanchett" simply does not exist except in combination with the air valve. Its purpose is to *let air into the bottle*. The majority does not explain and I am at a loss to understand how the Matzen container with *the entire Blanchett nipple* on it can collapse or how it can provide a container in which air is excluded during nursing.

Under comparable circumstances, this court in *In re Shaffer*, 229 F.2d 476, 43 CCPA 758, stated the view that:

\* \* \* a person having the references before him who was not cognizant of appellant's disclosure would not be informed that the problems solved by appellant ever existed. Therefore, can it be said that these references which never recognized appellant's problem would have suggested its solution? We think not, and therefore feel that the references were improperly combined since there is no suggestion in either of the references that they can be combined to produce appellant's result.

Further, I fail to see how the combination created by the majority would provide the result called for in the "whereby" clause of claim 25 which reads as follows:

\* \* \* whereby the interior of the container is sealed and during nursing the container contents are withdrawn without admission of air to the container, causing collapse of the bottom container section.

What has been said above as to claim 25 and the failure of the references to make its distinctive features obvious, applies also to the other appealed claims. Thus claim 26 requires "a cross-cut valve" in the end of the nipple in the novel combination claimed in claim 25.

While all of the above features also are inherent in appealed claim 27, this

claim further defines the shape of the top portion of the container as follows:

\* \* \* a top section of self-sustaining formed sheet material having a configuration generally that of a portion of sphere less than a hemisphere \* \* \* It defines the bottom section as follows:

\* \* \* a bottom section of formed flexible plastic material having a configuration of a portion of a sphere less than a hemisphere and of a size substantially the same as that of the top section \* \* \*

Further limitations as to the shape of the container are found in claim 28 as follows:

\* \* \* wherein said top and bottom sections each are portions of a sphere of equal diameter, the portions being defined by a central angle of the order of 80 degrees and the sections are sealed together along a planar, circumferential area, said sealed area extending outwardly from the container.

These distinctions are ignored by the majority, apparently for the stated reason that:

\* \* \* Appellants have presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container of Matzen. \* \* \*

It is seldom that one finds so clear a case of (1) ignoring an appellant's teachings and (2) of hindsight reconstruction of the art in view of appellants own disclosure. Upon turning to the record, we find the majority's statement to be totally without support. In appellants' specification it is stated that:

\* \* \* Both sections have a generally spherical configuration and are somewhat less than hemispherical in extent. In the specific container illustrated in the drawings, the two sections

are defined by a central angle of 80°. This relationship defines a finished container of rounded configuration and is essential to hold. \* \* \* [Emphasis added.]

Appellants also disclose the particular shape of their container as a convenient one for use and the lengths in describing how it is held. Thus in their specification stated:

\* \* \* In nursing an infant the container is preferably held as shown in Figure 7 with the second section inserted through opening 38 extending outwardly from the top line 13 of the container section. The sections are preferably formed as an integral part of the sections. The peripheral edge of the two container sections is grasped by the thumb and one side of tab 39 and the other side of tab 40 and the little finger on the other side of the bottom of the container against the palm of the hand to form an extremely stable support for the container 10 which may readily be moved to accommodate changes in the position of the infant. The thin flange and light weight of the container permit the baby to hold the container and feed itself at an angle without the need of a heavy glass nursing bottle. [Emphasis added.]

Should this not be a sufficient argument in favor of the particular configuration of the container, the specification also states:

\* \* \* The over-all shape of the container conforms generally to the shape of the mother's breast to provide further inducement to the infant to nurse.

To the foregoing, I would add the observation that when one starts with the concept of a disposable device, the concept of cost becomes an important consideration. It is a known fact of which the majority should have taken judicial notice that the spherical form provides

defines the shape of the top of the container as follows:

top section of self-sustaining material having a configuration generally that of a portion of a sphere less than a hemisphere \* \* \* the bottom section as follows:

bottom section of formed plastic material having a configuration of a portion of a sphere less than a hemisphere and of a size substantially the same as that of the top \* \*

ifications as to the shape of the container are found in claim 28 as

wherein said top and bottom sections are portions of a sphere of the same diameter, the portions being defined by a central angle of the order of 80° and the sections are sealed along a planar, circumferential line in said sealed area extending from the container.

sections are ignored by the court recently for the stated reason

appellants have presented no evidence which convinces us that the configuration of their container is significant or is anything more than the result of numerous configurations of ordinary skill in the art and obvious for the purpose of forming mating surfaces in the container of Matzen. \* \* \*

that one finds so clear a showing of an appellant's teaching of hindsight reconstruction in view of appellants' own disavowal, turning to the record, we find Matzen's statement to be totally correct. In appellants' specification stated that:

the top and bottom sections have a generally spherical configuration and are substantially hemispherical in external shape. In the specific container illustrated in the drawings, the two sections

are defined by a central angle of the order of 80°. *This relationship provides a finished container which has a rounded configuration and is convenient to hold.* \* \* \* [Emphasis added.]

Appellants also disclose that the particular shape of their container is a convenient one for use and go to some lengths in describing how it can be readily held. Thus in their specification it is stated:

\* \* \* In nursing an infant, the container is preferably held as illustrated in Figure 7 with the second finger inserted through opening 38 in a tab 39 extending outwardly from the juncture line 13 of the container sections, and preferably formed as an integral part of the sections. *The peripheral edge 40 of the two container sections is grasped by the thumb and forefinger on one side of tab 39 and by the third and little finger on the other side with the bottom of the container resting against the palm of the hand. This is an extremely stable support for container 10 which may readily be moved to accommodate changes in the position of the infant.* The thin peripheral flange and light weight of the container permit the baby to hold the container and feed itself at an earlier age than with a heavy glass nursing bottle. [Emphasis added.]

Should this not be a sufficient argument in favor of the particular configuration of the container, the specification also states:

\* \* \* The over-all shape of the container conforms generally with the shape of the mother's breast adding further inducement to the baby to nurse.

To the foregoing, I would add the observation that when one starts with the concept of a disposable device, the factor of cost becomes an important consideration. It is a known fact of which the majority should have taken judicial notice that the spherical form provides the

most efficient form of container in terms of the amount of surface materials required for a container of a given capacity. Thus, it seems to me the shape of the container as claimed is its own most effective "argument" as to the importance of the claimed shape for, the closer the shape approaches that of a true sphere, the more efficient becomes the use of the surface forming materials and hence the lower the material cost of the container. The art of record is devoid of any such concept.

It should be clear from the foregoing that "the invention as a whole," with which we should be here concerned under the mandate of 35 U.S.C. § 103, is a unitary whole, in this case a disposable infant feeding device which on this record is *unique in concept and novel and unobvious in construction*. By the simple expedient of ignoring the phrase in section 103 "at the time the invention was made," it has been possible for the majority to use appellants' own teachings as the basis for its hindsight reconstruction of the art upon which it bases its finding of obviousness.

But is the "invention as a whole" simply the gathering together of individually old elements in the art? The majority obviously thinks it is and appears to be satisfied to predicate its decision on the showing of a prior art bottle having a collapsible wall construction to which it adds an *air vented* nipple construction from another patent. While the majority has seen fit to pay lip service to the decision in *Graham v. John Deere Co.* of Kansas City, 86 S.Ct. 684, it is my opinion that it has ignored the fundamental rationale of the case which, as I view it, would prohibit the type of obviousness rejection which the majority here affirms. That rationale requires us to follow the conditions of section 103 "realistically;" to place the emphasis on "inquiry, not quality;" and to make the "basic factual inquiries" (1) as to the scope and content of the prior art, (2) the differences between the prior art and the claims at issue, and (3) the level of ordinary skill in the art.

Such a factual inquiry should start with asking the fundamental question as to "why" appellants sought the claimed construction. As we pursue the answer to this question we begin to see that factually their "invention as a whole" embraces more than the factors considered by the majority. Perhaps we can find the factual answer to this "why" in the frustration of a parent who has walked the floor with a crying infant who, nursed with a Blanchett nipple, has ingested a large quantity of air with its feeding. Perhaps it is to be found in the concern of harassed nurses in a maternity ward who face the same problem without the time or patience to walk the floor with each similarly distressed infant. Perhaps it is found in the demands of the modern mother who wants all things, particularly feeding formulas for her baby, nicely prepackaged in a sterile container which is easy to use and inexpensive enough to be thrown away, thus eliminating the troublesome washing and sterilizing of the prior art units to permit their intended reuse.

Wherever we may go to find the answer as to "why" appellants concerned themselves with this problem is of little present moment except to suggest the various factual facets of the pre-existing problem which on this record was first solved by the nursing device here claimed.

It is seldom that we find as clear a case of pure hindsight reconstruction of the prior art as is found in the present majority opinion. I do not consider this to be the type of factual "inquiry" stressed by the Supreme Court in the *Deere* case, supra. Apparently impressed by the admitted simplicity of the claimed device, the reasoning of the majority, which it seems to me is substituted for a *factual* inquiry, seems to come down to this, "we have seen appellants' device; it is simple; ergo it is obvious." Such reasoning indeed lends support for the callous observation of some years ago which has been attributed to Mr. Causten Browne that "If it [the invention] is so simple that a judge can understand it, then it is not in-

vention." It is here the caution stated in *Allen v. Standard Crankshaft & Hydraulic Co.*, 323 F.2d 29 (4th Cir. 1963) should be observed:

In approaching the question of obviousness, however, judges should mistrust their subjective notions if there are objective indicia to guide their judgments. Though the answer after the event may appear simple, the Court should not convert its simplicity into obviousness in the face of hard proof of recognized need for the answer, of long, unsuccessful search for the answer by people of skill in the art, of recognition by the industry that the claimed invention was the answer, and of its prompt adoption with attendant commercial success. Even a substantial combination of some of such criteria ought to outweigh a judge's subjective convictions that if one as skilled as he had really looked for the answer, he immediately could have put his finger upon it.

Unfortunately the *simplicity* of the present device has been converted into *obviousness* by the majority. There is indeed no great "mystery" about the present invention which can be secreted in some exotic chemical formula. There is here no great scientific "break-through" which can be expressed in the mystique of mathematical symbolism. But are these the requirements to be met before an invention is patentable under 35 U.S.C. § 103? I think not. As stated by Judge Learned Hand in *Reiner v. I. Leon Co.*, 285 F.2d 501 (2d Cir. 1960):

\* \* \* To judge on our own that this or that new assemblage of old factors was, or was not, "obvious" is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it. \* \* \*

Here as in many commercially significant inventions, the simplicity of the device is the very thing which had eluded the art. Here as in *Dewey v. Almy Chem-*

*Co. v. Mimex Co.*, 124 F.2d 1942):

\* \* \* It would indeed rank the invention as a great one such as come only at rare intervals and are the work of genius. \* \* \* inventors did not move a step in a marked way; they struck a path which led to a goal they had unsuccessfully tried to reach for years. To say that for the ordinary routineer, one's eyes to all the significant fallacies of the majority opinion to me to be the same as the unaccepted position of the majority was predicated in *United States v. Adams*, 86 S.Ct. 708. In *con-* the Adams battery was non- court pointed to the operational characteristics of the Adams battery found to be "unexpected and surpassed then-existing work." The opinion then continues 483-84:

\* \* \* Despite the fact that the elements of the Adams battery were well known in the prior art and that they were put together as did Adams, it is not to be said that a person reasonably skilled in the art of the prior art must ignore that (1) the Adams battery, which continued to operate in a circuit and which heated in operation, were not practical; and (2) activated batteries were only when combined with a certain material detrimental to the use of the battery. These long-accepted facts, taken together, would, we believe, have led to any investigation into such a combination as is used by Adams. It is to say that one who merely looks for old inventions by his eyes to their prior disadvantages, discovers a patentable invention. We do say, however, that the advantages in old devices do not naturally discourage the search for new inventions may be taken in determining obviousness. For the foregoing reasons, we reverse.



Co. v. Mimex Co., 124 F.2d 986 (2d Cir. 1942):<sup>53</sup> CCPA

Application of Douglas J. BRIDGEFORD.

Patent Appeal No. 7492.

United States Court of Customs  
and Patent Appeals.

March 24, 1966.

Rehearing Denied June 9, 1966.

Examiner rejected claims of application for patent, and the Board of Appeals of Patent Office, Serial No. 718,996, affirmed the decision, and the applicant appealed. The United States Court of Customs and Patent Appeals, Smith, J., held that where product type claims of application for patent for composite polymeric material consisting of wood fibers or cellulose fibers isolated from wood having guest polymer of an olefinically unsaturated monomer deposited in situ within host material and product-by-process type patent claims defined same patentable subject matter, differing only in scope, application was properly denied on ground of double patenting.

Decision of Board of Appeals affirmed.

# 1. Patents $\S$ 101(5, 11)

Right to patent on invention is not to be denied because of limitations of English language, and, in proper case, product may be defined by process of making it, but invention so defined is a product and not a process.

# 2. Patents $\S$ 101(5)

Limitations of known technology concerning subject matter sought to be patented should not arbitrarily defeat right to patent on invention.

# 3. Patents $\S$ 101(5)

Whether invention be defined in terms of structure of compound, or its novel characteristics, or by defining it in terms of process by which it is produced, or in proper case, by employing more than one of those methods of defining invention, right to patent on invention is

here the caution stated in  
ard Crankshaft & Hy-  
F.2d 29 (4th Cir. 1963)  
ved:

hing the question of ob-  
wever, judges should mis-  
objective notions if there  
indicia to guide their  
Though the answer after  
appear simple, the Court  
nvert its simplicity into  
n the face of hard proof of  
ed for the answer, of long,  
search for the answer by  
l in the art, of recognition  
ry that the claimed inven-  
answer, and of its prompt  
h attendant commercial  
en a substantial combina-  
of such criteria ought to  
judge's subjective convic-  
one as skilled as he had  
l for the answer, he im-  
uld have put his finger up-

ly the *simplicity* of the  
has been converted into  
the majority. There is  
eat "mystery" about the  
ion which can be secreted  
chemical formula. There  
great scientific "break-  
h can be expressed in the  
mathematical symbolism.  
the requirements to be  
invention is patentable un-  
 $\S$  103? I think not. As  
re Learned Hand in Reiner  
, 285 F.2d 501 (2d Cir.

judge on our own that this  
assemblage of old factors  
not, "obvious" is to sub-  
ignorance for the acquaint-  
e subject of those who were  
h it. \* \* \*

many commercially signifi-  
is, the simplicity of the de-  
ry thing which had eluded  
as in Dewey v. Almy Chem.

\* \* \* It would indeed be absurd to rank the invention as a great pioneer such as come only at rare intervals and are the work of genius. \* \* \* These inventors did not move along a well-marked way; they struck out a new path which led to a goal that men had unsuccessfully tried to reach for many years. To say that for this they needed to look no further afield than the ordinary routineer, one must shut one's eyes to all the significant facts.

The fallacies of the majority here seem to me to be the same as those on which the unaccepted position of the Government was predicated in United States v. Adams, 86 S.Ct. 708. In concluding that the Adams battery was non-obvious, the court pointed to the operating characteristics of the Adams battery which it found to be "unexpected and to have far surpassed then-existing wet batteries." The opinion then continues, at USPQ 483-84:

\* \* \* Despite the fact that each of the elements of the Adams battery was well known in the prior art, to combine them together as did Adams required that a person reasonably skilled in the prior art must ignore that (1) batteries which continued to operate on an open circuit and which heated in normal use were not practical; and (2) water-activated batteries were successful only when combined with electrolytes detrimental to the use of magnesium. These long-accepted factors, when taken together, would, we believe, deter any investigation into such a combination as is used by Adams. This is not to say that one who merely finds new uses for old inventions by shutting his eyes to their prior disadvantages thereby discovers a patentable innovation. We do say, however, that known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness.

For the foregoing reasons, I would re-verse.

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